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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|-------------------|
| 09/912,804 | 07/24/2001 | Surya Prakash | 06618/408002/CIT2942-D | 7226 |
| 20985 | 7590 | 10/20/2005 | EXAMINER | |
| FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081 | | | | MERCADO, JULIAN A |
| ART UNIT | | PAPER NUMBER | | |
| | | 1745 | | |

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/912,804 | PRAKASH ET AL. | |
| | Examiner | Art Unit | |
| | Julian Mercado | 1745 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 August 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-3, 5 and 12-14 is/are allowed.
- 6) Claim(s) 4 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

This Office action is responsive to applicant's amendment filed August 8, 2005.

Claims 1-5 and 12-14 are pending.

Claim Objections

Claim 1 is objected to because of the following informalities:

- a. In claim 1 at line 6, it is suggested to change "where the first and second ionomers" to --wherein the first and second ionomers--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a first and second ionomer, does not reasonably provide enablement for the catalyst ink to further comprise an ionomer, i.e. a third ionomer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

It appears to the examiner that claim 4 should be amended to replace "further comprises an ionomer" with --comprises the second ionomer--.

Claim Rejections - 35 USC § 102

The rejection of claims 1-5 and 11 under 35 U.S.C. 102(e) based on Narayanan et al. (U.S. Pat. 5,945,231) has been obviated.

The examiner acquiesces with applicant's assertion that the present amendment, in reciting a membrane portion and a catalyst ink, obviates the examiner's prior interpretation of a PSSA and Kynar ink as being readable on a membrane. In Narayanan et al., the membrane is disclosed as NAFION or other proton exchange membranes. See col. 3 line 55-57. Thus, Narayanan et al. is not considered to teach or suggest the claimed PSSA-PVDF membrane comprising a membrane portion and a catalyst ink.

Claim Rejections - 35 USC § 103

The rejection of claims 12-14 under 35 U.S.C. 103(a) based on Narayanan et al. and Prakash et al. (U.S. Pat. 6,444,343) has been withdrawn.

Terminal Disclaimer

The terminal disclaimer filed on August 2, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,444,343 B1 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Allowable Subject Matter

Claims 1-3, 5 and 12-14 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a PSSA-PVDF membrane comprising a membrane portion formed of PSSA and PVDF and a first ionomer and a catalyst ink comprising PVDF and a second ionomer, wherein the first and second ionomers are formed from the same material.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


WILLIAM KRYNSKI
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 1700